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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,750	06/27/2003	Naohiro Toda	239522US0	7361

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EXAMINER

NOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/606,750

Applicant(s)

TODA ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see the attached, paragraph 2.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 7-23, 28 and 29.
Claim(s) withdrawn from consideration: 24-26.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached, paragraph 3.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 5/23/06; 8/25/06
13. ☐ Other: _____.

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1700

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1. For purposes of appeal, the proposed amendment filed on Aug. 25, 2006, will be entered upon the filing of the appeal brief and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal:

Claims 1, 7-23, 28, and 29 would be rejected for the reasons set forth in paragraphs 9-12, 14-17, 20, and 21 of the final Office action mailed May 26, 2006.

Paragraph 9:

Claims 1, 7, 8, 10-14, 16-20, 22, 23, 28, and 29 would be rejected under 35 U.S.C. 103(a) over US 2002/0076633 A1 (Niimi'633), as evidenced by applicants' admission at page 87, lines 2-23, of the instant specification (applicants' admission I), combined with: (1) US 6,268,096 B1 (Nukada), as evidenced by the ACS File Registry RN 26201-32-1; and (2) US 6,623,899 B2 (Takaya), for the reasons discussed in paragraph 9 of the final Office action.

Paragraph 10:

Claims 20-22 would be rejected under 35 U.S.C. 103(a) over Niimi'633, as evidenced by applicants' admission I, combined with: (1) Nukada, as evidenced by the ACS File Registry RN 26201-32-1; and (2) Takaya, as applied to claim 20 above,

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further combined with US 2002/0051654 A1 (Niimi'654), for the reasons discussed in paragraph 10 of the final Office action.

Paragraph 11:

Claims 1, 7, 8, 10, 14, 15, 17, 19, 23, 28, and 29 would be rejected under 35 U.S.C. 103(a) over US 6,399,262 B1 (Oshiba) combined with Nukada, as evidenced by the ACS File Registry RN 26201-32-1, for the reasons discussed in paragraph 11 of the final Office action.

Paragraph 12:

Claim 9 would be rejected under 35 U.S.C. 103(a) over Oshiba combined with Nukada, as evidenced by the ACS File Registry RN 26201-32-1, as applied to claim 1 above, further combined with US 5,496,671 (Tamura), for the reasons discussed in paragraph 12 of the final Office action.

Paragraph 14:

Claims 1, 8, 10-14, 16-20, 22, 23, 28, and 29 would be rejected under 35 U.S.C. 103(a) over Niimi'633, as evidenced by applicants' admission I, combined with (1) Japanese Patent 11-140337 (JP'337), as evidenced by Ladd et al., Structure Determination by X-ray Diffraction, p. 426 (Ladd), and (2) Takaya, for the reasons discussed in paragraph 14 of the final Office action.

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Paragraph 15:

Claims 20-22 would be rejected under 35 U.S.C. 103(a) over Niimi'633, as evidenced by applicants' admission I, combined with: (1) JP'337, as evidenced by Ladd, and (2) Takaya, as applied to claim 20 above, further combined with Niimi'654, for the reasons discussed in paragraph 15 of the final Office action.

Paragraph 16:

Claims 1, 8, 10, 14, 15, 17, 19, 23, 28, and 29 would be rejected under 35 U.S.C. 103(a) over Oshiba combined with JP'337, as evidenced by Ladd, for the reasons discussed in paragraph 16 of the final Office action.

Paragraph 17:

Claim 9 would be rejected under 35 U.S.C. 103(a) over Oshiba combined with JP'337, as evidenced by Ladd, as applied to claim 1, further combined with Tamura, for the reasons discussed in paragraph 17 of the final Office action.

Paragraph 20:

Claims 1, 7-23, 28, and 29 would be rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-18 and 20-27 of copending Application No. 10/804,067 (Application'067), as evidenced by that portion of the disclosure in Application'067 that supports the claimed

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subject matter in claims 1-18 and 20-27 of Application'067, and the ACS File Registry RN 26201-32-1, for the reasons discussed in paragraph 20 of the final Office action.

Paragraph 21:

Claims 1, 8-10, 15-18, 20-23, 28, and 29 would be rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-18 of copending Application No. 10/656,280 (Application'280), as evidenced by that portion of the disclosure in Application'280 that supports the claimed subject matter in claims 1-18 of Application'280, and the ACS File Registry RN 26201-32-1, in view of Takaya and Suzuki, for the reasons discussed in paragraph 21 of the final Office action.

2. The terminal disclaimer filed on Aug. 25, 2006, disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 7,029,810 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Accordingly, the rejection of claims 1, 7-23, 28, and 29 under the judicially created doctrine of obviousness-type double patenting over claims 1-35 of US Patent No. 7,029,810 B2 (Toda),

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set forth in the final office action mailed on May 26, 2006, paragraph 19, has been withdrawn.

The objection to claims 1 and 29 set forth in the final office action mailed on May 26, 2006, paragraph 6, would be withdrawn in response to the amendment to claims 1 and 29 set forth in the amendment filed on Aug. 25, 2006, which will be entered upon the filing of an appeal brief.

3. Applicants' arguments set forth in the amendment filed after the final rejection on Aug. 25, 2006, are not persuasive to overcome the prior art rejections set forth in paragraphs 9-12 for the reasons discussed in the final rejection.

Applicants further assert that the X-ray diffraction pattern in Fig. 4 of Nukada does not have a peak at 23.5° . Applicants assert that the "projection observed at an angle slightly lower than 23.5° is not a peak."

Applicants' assertions are not persuasive. As discussed in the rejection in the final rejection, paragraph 9, page 8, the Nukada titanyl phthalocyanine crystal X-ray diffraction pattern in Fig. 4 exhibits a peak at a Bragg angle of $23.5^\circ \pm 0.2^\circ$. The examiner notes that, contrary to applicants' assertion, if the line at 23.5° from the angle-axis were drawn perpendicular to the

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angle-axis in contrast to the existing line, which appears to tilt slightly to the right, applicants' copy of the Nukada Fig. 4 would also show a peak at around $23.5^{\circ} \pm 0.2^{\circ}$.

Furthermore, applicants' assertion that the Nukada peak at around $23.5^{\circ} \pm 0.2^{\circ}$ is not a peak but a "projection" is mere attorney argument. Applicants have not pointed to any objective evidence to support their assertion. Moreover, applicants are reminded that independent claim 28 does not require that the X-ray diffraction pattern have a peak at a Bragg angle of $23.5^{\circ} \pm 0.2^{\circ}$.

Applicants further assert that the Nukada X-ray diffraction pattern in Fig. 4 differs from that in Fig. 13 in the present application because Fig. 13 has two clear peaks (9.5° and 9.7°) whereas Nukada's Fig. 4 has "no clear peak in the range." However, instant independent claims 1 and 28 do not require that the titanyl phthalocyanine crystal X-ray diffraction pattern have such two "clear" peaks as shown in Fig. 13. Applicants cannot argue patentability based on limitations that are not present in the claims.

Accordingly, for the reasons discussed in the rejections over Niimi'633 combined with Nukada and in the rejections over Oshiba combined with Nukada in paragraphs 9-12 of the final rejection, the subject matter recited in the instant claims

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would have been rendered prima facie obvious over the combined teachings of the cited prior art. The rejections over the cited prior art, set forth in paragraphs 9-12 of the final rejection, stand.

4. The examiner has considered the copending US applications listed on the "List of related cases" in the Information Disclosure statement filed on May 23, 2006.

The information disclosure statement (IDS) submitted on Aug. 25, 2006, was filed after the mailing date of the final rejection on May 26, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the copending US application listed in the "List of related cases" in that IDS.